

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Applicant: Dacosta	)	Art Unit: 2145
	)	
Serial No.: 10/782,345	)	Examiner: Hossain
	)	
Filed: February 19, 2004	)	50T5722.02
	)	
For: SYSTEM AND METHOD FOR AUTHENTICATING	)	September 12, 2008
COMPONENTS IN WIRELESS HOME	)	750 B STREET, Suite 3120
ENTERTAINMENT SYSTEM	)	San Diego, CA 92101
	)	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents  
Alexandria, VA

Dear Sir:

The issues Applicant would like to have reviewed prior to the filing of an appeal brief are as follows.

In the Office Action dated June 12, 2008, all elected claims (1, 2, and 4-13) have been rejected under 35 U.S.C. §103 as being unpatentable over Kamieniecki, USPN 7,162,733 in view of Hayes, USPP 2006/0259184. The rejections allege that the primary reference, col. 5, lines 1-11, col. 5, line 56-col. 6, line 11, and col. 7, lines 59-62 teaches that a component, alleged to have a primary communication system configured with a primary communication system of a server, sends information to the server using a secondary communication system that is out of band with the primary system, admitting that Kamieniecki fails to teach sending configuration information and relying on Hayes, paragraphs 24 and 45 for the shortfall. The rejections are traversed for contradicting findings of fact in the Restriction Requirement dated February 26,

2008 and for being based on clearly erroneous findings of fact regarding the teachings of the applied references.

**Actual Teachings of Relied-Upon Parts of Kamieniecki**

While the system of Kamieniecki indeed uses more than a single channel of communication, *no two components in Kamieniecki* communicate with each other using more than one of the system channels. In contrast, Claim 1 requires two entities to communicate with each other using each of two systems, a primary and a secondary, and of course for additional claimed purposes. This appears to have escaped the examiner, who does not appear to realize that cable system in the reference is used by one pair of components and the IR control system is used by another pair of components.

Commencing with a detailed analysis of Kamieniecki, col. 5, lines 1-11 simply teaches, in relevant part, that a headend communicates with a device 100 through a cable plant, apparently using one and only one communication system to do so.

Col. 5, line 56-col. 6, line 11 of Kamieniecki teaches only that remote control devices communicate with components of a home entertainment system - not the headend, and not using two or more communication systems. Col. 7, lines 59-62 add nothing relevant. There is no teaching here of communication between any two components using anything more than a single communication system. Accordingly, not a single one of the sections of Kamieniecki relied on for the proposition of using a secondary, out-of-band communication system between two components in fact teaches any such thing, much less in the context of Claim 1, rendering the rejections reversible error for being based on clearly erroneous findings of fact.

**Actual Teaching of Relied-Upon Parts of Hayes**

Paragraph 24 of Hayes says nothing about configuration information, contrary to the allegation in the Office Action. Instead, paragraph 24 teaches that a remote control can include a camera, microphone, and/or touchscreen display and may also be configured to include appliance, control server, and content server functions. By this, Hayes clarifies that the remote control may be implemented on a variety of computer devices to (1) playback content; (2) monitor tables for advanced control functions, and (3) include programming for location determination methods. But playing back content, monitoring functions, and determining a location are not the same thing as exchanging configuration information and do not necessitate or for that matter even imply such, particularly not the specific configuration information now included in Claim 1.

Paragraph 45 of Hayes is of no further help to the prima facie case because it teaches nothing about configuration information, much less communicating it across an out of band secondary system. Instead, it teaches that a user can save, by transmitting a coded signal in IR, RF or other protocol, to suspend, store, transmit, and resume a session state, meaning that both the playback state of the media, as well as the device configurations and settings during playback, can be saved for later recall. But the "device configurations" of this paragraph are not to be confused with "configuration information", because the paragraph goes on to teach that, to ensure that media playback and device state settings transfer correctly to a set of second home entertainment center devices, a set of device conversion definitions is applied to each data element from the first entertainment center (e.g., television settings data, audio receiver settings data, etc.) In other words, by "device configurations" Hayes apparently means the channel and volume that was being played, not "configuration information" as that term is understood by those of skill in the art, see MPEP §2111.01 (the

examiner must interpret claims as one skilled in the art would). In any case, all of the communication between the relevant components in this paragraph - an entertainment system on the one hand, and the remote Control on the other - are using one and only system, i.e., IR or RF or other protocol.

The allegation *apropos* Claim 2 that Kamieniecki's abstract teaches a server sending configuration information using a secondary communication system to a component is both wrong and inconsistent with the admission noted above made in relation to Claim 1. The abstract teaches automatic set-up of an electronic device having multiple user-controllable functionalities using interactive menu to select and set a functionality to a desired setting. Setting a functionality, however, is not exchanging configuration information. As taught by the abstract, functionality set up is achieved by transmitting a menu selection using an IR beam, i.e., using one and only one communication system, not two.

The allegation regarding former Claim 3 that Hayes, paragraphs 24 and 45 teach an encryption key, an address, and an ID is simply wrong, as a perusal of these paragraphs conclusively demonstrates.

The allegations that various dependent claim limitations, including those of Claims 4, 6, 8, 12, and 16, are mere matters of design choice or are well-known in the art are illegitimate, being unsupported by evidence: a statement that modifications of the prior art to meet the claimed invention would have been "within the ordinary skill of the art at the time the claimed invention was made" is not sufficient to establish a prima facie case of obviousness without some objective reason suggested by the prior art, MPEP §2143.01, first, second, and seventh paragraphs.


#### Contradictory Findings of Fact

In the Restriction Requirement dated February 26, 2008, the examiner placed on the written record a finding of fact that the elected claims, in Class 455, subclass 73, were patentably distinct from Group II

claims in Class 709, subclass 237 and Group III claims in Class 455, subclass 3.01 because the elected claims "may be implemented separately" from Group II and III (page 2, last two lines) and moreover "have acquired a separate status in the art as shown by their different classifications", page 3, lines 1 and 2. The exact same rationale holds for finding the elected claims patentably distinct from Kamieniecki (Classes 725 and 348) and Hayes (Class 700), both of which are in different classifications than the elected claims and both of which can be implemented separately from the elected claims as is *ipso facto* admitted in the examiner's allegation that the references pre-date the present claims and thus were implemented before the present claims were filed.

The PTO is governed by the Administrative Procedures Act (APA), Dickinson v. Zurko, 527 U.S. 150 (1999). Under the APA, rendering mutually exclusive findings of fact is reversible arbitrary and capricious agency action. The rejections, being predicated on a finding fact that is diametrically opposed to those placed on the written record in February, are reversible legal error.

Respectfully submitted,

  
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